

REMARKS

The Office Action asserts at p. 3, first paragraph, “the method of Group I is known in the art as disclosed by Virtanen (US 6,342,349). This reference is described below.” Applicants respectfully note that a full review of the Office Action fails to reveal the existence of any discussion, description, or even an additional reference therein to US 6,342,349. In the absence of any further reference to such patent, Applicants will consider that such patent is not regarded as presenting any issue as to the patentability of the claims in the present Application.

A number of species claims are not considered in the Office Action. Because favorable disposition of generic claims and subsequent examination of species claims that are presently not considered could affect the relevance of a Petition Under 37 C.F.R. § 1.144, the filing of such Petition is deferred until further claim disposition is established. This deferral does not imply that Applicants acquiesce to the restriction/species election requirements, or that Applicants agree with the answers to the arguments with traverse to the restriction/species election requirements provided in the Office Action.

Claims 1, 29, and 30 do not recite the terms “so-called intelligent material”. The rejection asserted in the Office Action under 35 U.S.C. § 112 ¶ 1 refers to such specific claim language as allegedly providing support to such rejection. No other reference to specific claim language is provided in the Office Action regarding the same rejection. Because claims 1, 29, and 30 do not recite the quoted terms, Applicants respectfully submit that the rejection under 35 U.S.C. § 112 ¶ 1 may not be made extensive to such claims, and respectfully request the withdrawal of such rejection.

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The terms “so-called intelligent material” are introduced, characterized and exemplified in the Application at, for example, p. 8, *ll.* 18-29, p. 9, *ll.* 1-15. Applicants respectfully submit that the present disclosure provides not only description, but also representative examples and supporting references regarding these terms. Because of the disclosure provided in the present Application, the quoted language in claim 31 with the quoted language referring to intelligent material satisfies the written description requirement. Applicants respectfully request the withdrawal of this rejection.

The Office Action makes general assertions on the written description requirement, but the only instance in which it refers to actual claim language in the present Application is the language from claim 31 already addressed herein. Absent clear references to claim language and absent reasoning on how the general statements could apply to specific claim language, Applicants provide no further comment and understand that there is no additional issue regarding the written restriction requirement as applied to the present claims.

The specific rejections under 35 U.S.C. § 112 ¶ 2 are addressed herein under the same reference letters A-F that are used in the Office Action.

A. Claim 2, and also claims 4, 27, 28 and 41 by incorporation, recite, *inter alia*, as follows: “step (a) comprises (i) disposing the analytes within individually identifiable containers, and (ii) transferring the analytes from the containers to the at least one solid support”. Step (a) is recited in independent claim 1 as follows: “simultaneously applying a plurality of analytes to the screened onto at least one solid support such that ...”. The Office Action indicates “the elected species of solid support is film or tape” and alleges “it is unclear how the ‘film or tape’ can be placed in individually identifiable containers or different compartments.” It follows from the claim language quoted above that such language does not recite that film or

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tape is placed in individually identifiable containers or different compartments, because the quoted claim language does not recite that the solid support is placed in individually identifiable containers or different compartments.

B. Applicants respectfully submit that the meaning of terms “spontaneous release of the analytes” and “controlled release of the analytes” is ascertainable and known to those of ordinary skill in the art. Therefore, one of ordinary skill in the art would understand what is claimed in claims 6 and 7 when the claims are read in light of the specification. Furthermore, the specification provides in the present Application characterization and examples of such terms. *See, e.g.*, Application, p. 6, *ll.* 17-18, p. 6, *ll.* 20-21, p. 8, *ll.* 1-5, 14-29, p. 9, *ll.* 1-17.

C. Claims 17-19 recite choices for the nature and/or characteristics of the solid support. Such recitals are provided with specific terminology, and no reference or reasoning has been provided in the Office Action to show that one of ordinary skill in the art would not be able to ascertain with a reasonable degree of particularity and distinctness what these claims define. Expressions such as providing a film or tape with a coating, providing a film or tape that carries information in electronic, magnetic or digitized form, and providing a film or tape that is reflective, use terms that are common and understandable by the person or ordinary skill in the art.

D. Claim 1 recites, *inter alia*, “applying a plurality of analytes ... onto at least one solid support”. Claim 25 depends from claim 1 and further recites “wherein each analyte is applied to a single solid support”. No issue as to the compliance of this claim language with 35 U.S.C. § 112 ¶ 2 has been raised as to the generic term “single solid support”. No reference or reasoning has been provided in the Office Action to show that one of ordinary skill in the art would not be able to ascertain with a reasonable degree of particularity and distinctness what this claim defines when the solid support is a film or tape. Plain construction of the quoted language

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reveals that claim 25 recites, when the solid support is film or tape, that each analyte is applied to a single film or tape.

No reference or reasoning has been provided in the Office Action to show that one of ordinary skill in the art would not be able to ascertain with a reasonable degree of particularity and distinctness what claim 26 defines when the solid support is a film or tape, and the shape of the support is rod-like or spherical as recited in claim 26. Furthermore no reference or reasoning has been provided to show that the plain meaning of a film or tape with a spherical or rod-like shape would not be captured by one of ordinary skill in the art. Films are known to naturally exist in spherical shapes, such as in soap bubbles, and thin membranes are known to naturally exist in rod-like shapes, such as in bacilli and retinal rods. No reference or reasoning has been provided to show that such shapes as applied to manufactured articles would not be understood by one of ordinary skill in the art.

E. Definiteness of a claim has to “be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary skill in the pertinent art at the time the invention was made.” M.P.E.P. § 2173.02, p. 2100-199, col. 1 (Rev. 1, Feb. 2003). The present Application describes, characterizes and exemplifies the terms “so-called intelligent material” at, for example, p. 8, *ll.* 18-29, p. 9, *ll.* 1-15. It has not been shown that one of ordinary skill in the art would not be able to understand what is being claimed in claim 31 when such claim is read in light of the specification. *See also* M.P.E.P. § 2173.02, p. 2100-199, col. 2 (Rev. 1, Feb. 2003) (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)).

F. The term “rapid” in claim 1 is part of the preamble that states purpose or use of such claim. Claim 1 recites steps (a)-(c), which do not recite the quoted term as a limitation. Even if,

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arguendo, the term “rapid” were unclear, the actual recitation of steps (a)-(c) as provided in claim 1 would be understood by one of ordinary skill in the art as such, and therefore the preamble in the same claim does not render it indefinite.

For at least the foregoing reasons, Applicants respectfully submit that the claims comply with 35 U.S.C. § 112 ¶ 2 and request that the rejections asserted under this section be withdrawn.

The Office Action rejects a plurality of pending claims and alleges that U.S. Patent Application Ser. No. 09/253,153, Pub. No. 2002/0006604 A1, by A.W. Schwabacher (hereinafter “Schwabacher”) is an anticipatory reference that supports such rejection. As reasoned below, Applicants respectfully submit that Schwabacher is not an anticipatory reference under 35 U.S.C. § 102(e). Applicants respectfully request that such rejection be withdrawn.

Upon enactment of the Technical Amendment Act (H.R. 2215), a “U.S. application publication is prior art as of the application’s U.S. effective filing date”.¹ Schwabacher’s actual filing date is February 19, 1999. The present application is a nationalized application under 35 U.S.C. § 371 of PCT/IB98/01399, whose international filing date is September 8, 1998. Because this international filing date precedes Schwabacher’s actual filing date of February 19, 1999, Schwabacher may not be used as prior art against the present application in terms of Schwabacher’s actual filing date.

Schwabacher claims the benefit of U.S. 60/075,629, filed on February 21, 1998, (hereinafter referred to as “Schwabacher Provisional”). To the extent that the allegations of anticipation set forth in the Office Action are understood, Applicants respectfully submit that

¹ “35 U.S.C. §§ 102(e) and 374 as amended by H.R. 2215 (Technical Amendment Act)”, US PTO OPLA (14NOV2002), p. 3.

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Schwabacher is not an anticipatory reference in terms of Schwabacher Provisional's filing date for at least the following reasons.

The Office Action refers to the Abstract and to claims 32 and 34 in Schwabacher to support its allegations of anticipation. *See* Office Action, p. 9. These citations to Schwabacher do not appear to support such anticipation rejections for at least the following three reasons: Firstly, even if the Abstract in Schwabacher Provisional were regarded as part of the specification in such provisional patent application, pending claim 1² in the present Application would not read on the method disclosed in such abstract, because such abstract does not teach the features recited in claim 1. For example, claim 1 recites, *inter alia*, "contacting said at least one analyte-carrying solid support with targets provided in a semi-solid or liquid medium, whereby said analytes are released from the at least one solid support to the targets". The Abstract in Schwabacher Provisional does not disclose such features. Secondly, claim 32 in Schwabacher is not provided as such in Schwabacher Provisional, which only lists four claims. The Office Action has therefore not established (a) that claim 1 reads on the subject matter recited in claim 32 of Schwabacher, and (b) that claim 32, which is not listed as such in Schwabacher Provisional, is supported by Schwabacher Provisional to benefit from the earlier filing date of Schwabacher Provisional as the effective filing date for 35 U.S.C. § 102(e) purposes. Thirdly, even if claim 34 in Schwabacher were supported by Schwabacher Provisional, pending claim 1 in the present Application would not read in the method disclosed in such abstract, because such claim 34 does not teach the features recited in claim 1. For example, claim 1 recites, *inter alia*, "contacting said at least one analyte-carrying solid support with targets provided in a semi-solid or liquid medium, whereby said analytes are released from the at least one solid support to the targets". Claim 34 in Schwabacher Provisional, which is a

² The other claims that are rejected in the Office Action under 35 U.S.C. § 102 depend, directly or through other intervening dependent claims, from claim 1. Therefore, at least the reasoning set forth herein applies also to the other rejected claims.

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claim to a “method of obtaining structure-activity relationships from the compounds in a library”, does not disclose such features.

The Office Action refers as support for its allegations of anticipation to Schwabacher and specifically to “patented claims 32-37” therein. Office Action, p. 9, end of first paragraph.

Applicants respectfully note as follows: Claims 32-37 in Schwabacher are not “patented claims” because Schwabacher is cited in the Office Action as a published U.S. patent application, not as an issued U.S. patent. Furthermore, the Office Action refers to paragraph 0027 in Schwabacher in the context of characterizing the “support” in Schwabacher as a “tape” or as an “optical fiber”. Office Action, p. 9. Paragraph 0027 in Schwabacher sets forth the definition of the term “thread”. Upon review of such paragraph and of the definition of the term “thread” in Schwabacher Provisional, Applicants respectfully submit that such definitions do not appear to contain the terms “optical fiber”.

The Office Action refers generally to paragraphs 0029, 0031, and 0052-0071 in Schwabacher. There is no specific showing of what material in such paragraphs is alleged to anticipate any of the pending claims. Paragraphs 0052-0071 extend for almost 4.5 columns in Schwabacher and describe a plurality of embodiments and examples. No specificity is provided in the Office Action as to which of these embodiments and examples is/are relevant to the alleged anticipation of the rejected claims.

Even if disclosure in paragraphs 0029, 0031, and 0052-0071 in Schwabacher were relevant to the presently claimed methods, Applicants note that paragraphs 0029, 0031, and 0052-0071 in Schwabacher provide a significantly more extensive disclosure than Schwabacher Provisional provides. By way of illustration, but not as a unique example, compare paragraphs 0029, 0031, and 0052-0071 under the heading “Evaluation of Libraries for Activity” in Schwabacher, with the disclosure under the heading “Library Evaluation” in Schwabacher

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Provisional, that extends from line 15 to line 27 on page 9 and from line 1 to line 6 on page 10 in

Schwabacher Provisional.

The Office Action does not indicate on which specific material is relied on.

Furthermore, the Office Action does not show that its reasoning relies on material in

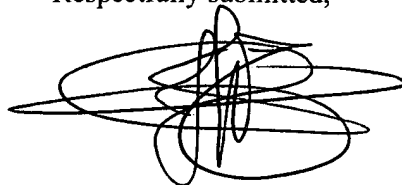
Schwabacher that is fully supported by the disclosure in Schwabacher Provisional.

Applicants respectfully submit that Schwabacher may not be used as an effective reference against the present Application, and it is respectfully requested that the rejections under 35 U.S.C. § 102(e) be withdrawn.

The Office Action acknowledges previously filed Information Disclosure Statements, and reports that PTO-1449 forms for such Filings are not in the PTO file. Copies of previously filed PTO-1449 forms are attached to the present Response. If the Examiner needs a copy, or copies, of any number of the items listed in such forms, Applicants will gladly endeavor to provide such material upon request.

Applicants respectfully submit that the claims are in condition for allowance and request that a timely Notice of Allowance be issued in this case.

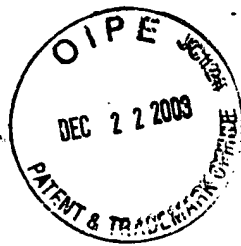
Respectfully submitted,

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the left.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Rudi Wilfried Jan PAUWELS, *et al.*
Serial No. : 09/530,907
Filed : June 30, 2000
Title : METHOD FOR THE RAPID SCREENING OF ANALYTES
Art Unit : 1639 (formerly 1627)
Examiner : Maurie Garcia Baker
Confirmation No.: 4853

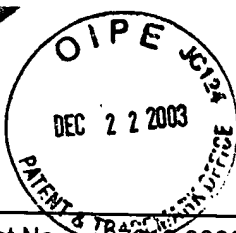
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JAN 07 2004

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ATTACHMENT TO RESPONSE "22DEC2003"

This attachment contains copies of previously filed PTO-1449 forms as requested by the Examiner in the Office Action.



INFORMATION DISCLOSURE CITATION
(Use several sheets if necessary)

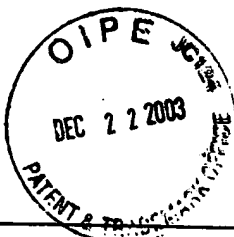
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Atty. Docket No.	07619.0006-00000	Serial No.	09/530,907			
Applicant	Rudi Wilfried Jan PAUWELS et al.					
Filing Date	June 30, 2000	Group:	1743			
U.S. PATENT DOCUMENTS						
Examiner Initial*	Document Number	Date	Name	Class	Sub Class	Filing Date If Appropriate
FOREIGN PATENT DOCUMENTS						
	Document Number	Date	Country	Class	Sub Class	Translation Yes or N
	WO 97/45730	12/04/97	PCT Int'l.			
	WO 98/38490	09/03/98	PCT Int'l.			
	WO 99/35496	07/15/99	PCT Int'l.			
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)						
Examiner	Date Considered					
*Examiner:	Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.					
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Examiner Initial*	Document Number	Date	Name	Class	Sub Class	Filing Date If Appropriate
	4,276,048	06/30/81	Leaback			
FOREIGN PATENT DOCUMENTS						
	Document Number	Date	Country	Class	Sub Class	Translation Yes or N
	WO 97/16569	05/09/97	WIPO/PCT			
	WO 98/01533	01/15/98	WIPO/PCT			
	WO 98/21571	05/22/98	WIPO/PCT			
	WO 99/30154	06/17/99	WIPO/PCT			
	2 008 767	06/06/79	United Kingdom			
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)						
	Nolan Sigal et al., "Approaches and Technologies for Screening Large Combinatorial Libraries," Combinatorial Chemistry and Molecular Diversity in Drug Discovery, pp. 433-443 (1998).					
	R. Ekins et al., "Multianalyte Microspot Immunoassay. The Microanalytical 'Compact Disk' of the Future," Ann. Biol. Clin., Vol. 50, No. 5, pp. 337-353 (1992).					
	Atsushi Suzuki et al., "Phase Transition in Polymer Gels Induced by Visible Light," Nature, Vol. 346, pp. 345-347 (1990).					
	Martin J. Snowden et al., "Some Like it Hot! Thermo-Sensitive Polymers," Chemistry & Industry, pp. 531-534 (1996).					
	Stephen P. Squinto, "Drug Discovery and Screening on a Compact Diskette," Presentation by Alexion Pharmaceuticals, Inc., IBC Drug Discovery Technology Conference, Boston, MA, (13 pages) (August 10-13, 1998).					
	"Turning the Human Genome Project into Drug Discovery", Presentation by Cadus Pharmaceutical Corporation at IBC Drug Discovery Technology Conference Boston, MA, (8 pages) (August 10-13, 1998).					
	Topics, Presentation and Exhibits of the IBC Drug Discovery Technology Conference, Boston, MA, (page 10) (August 12-13, 1998).					
Examiner		Date Considered				
*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.						
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Description of Third Annual Meeting of Society for Biomolecular Screening (SBS), San Diego, CA, (1 page), (September 22-25, 1997).						
Examiner				Date Considered			
*Examiner:	Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.						
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